

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 1, 2, 7-25 and 47-50, drawn to an electrophotographic photoreceptor and an apparatus and process cartridge containing the photoreceptor;
- Group II: Claims 26 and 27, drawn to a coating liquid;
- Group III: Claims 28 and 29, drawn to a method of preparing an electrophotographic photoreceptor; and
- Group IV: Claims 30-32, drawn to an image forming method.

In addition, the Examiner has indicated that the claims are directed to more than one species of the generic invention and he is also requiring election of an ultimate, single disclosed species identifying the following:

Claims 1, 26, 28 and 30 are generic to a plurality of disclosed patentably distinct species comprising:

(1) fillers that are either inorganic or organic (see specification page 37, line 19 to page 38, line 4); and

(2) organic compounds that are organic fatty acids, resins and copolymers having the specified acid value (see specification, page 44, line 23-26).

Applicants elect, with traverse, Group II, Claims 26 and 27. Further, Applicants elect, with traverse, (1) an inorganic filler, more specifically alumina; and (2) a polymer, oligomer or a copolymer having a saturated or unsaturated hydrocarbon skeleton and at least one

carboxyl group, more specifically styrene-acrylic resin. Claims 1-50 read on the elected species.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups or shown that a burden exists in searching all the claims.

The Office has characterized the inventions of Groups II and I as mutually exclusive species in an intermediate-final product relationship. Citing MPEP §806.04(b), third paragraph, the Office concludes that the intermediate product is useful as “a coating solution to coat a positive or negative acting photoresist.” The Office furthermore cites MPEP §806.04(h) in support of its assertion that the inventions are deemed patentably distinct on the ground that there is nothing on record to show them to be obvious variants. Applicants respectfully traverse the Restriction Requirement on the grounds that the Office has not provided evidence based on which to conclude that the intermediate products are useful as the Office has suggested. Moreover, Applicants respectfully submit that the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and is not on the Applicants to establish that they are not. Accordingly, the Restriction Requirement is believed to be improper, and it should be withdrawn.

In regard to Groups III and I, the Office has characterized the relationship between these two groups as “process of making and product made.” Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process such as “a dip coating method where a photoreceptor drum is dipped into the coating

solution and then dried.” However, there is no evidence of record to show that the claimed products could be made as the Office has alleged. If, in fact, the claimed product can be made by a “a dip coating method”, the Office has failed to show that the alleged process of “dip coating” is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups II and III as related as product and process of use. Citing MPEP §806.05(h), the Office suggests that the claimed product can be used in a materially different process such as “a dip coating method where a photoreceptor drum is dipped into the coating solution and then dried. Alternatively the product can be used in a process where the coating solution is coated onto the surface of a photoresist.” However, there is no evidence of record to show that the claimed product is useful as the Office has alleged. In addition, the Office has failed to show that its alleged use of the claimed product is materially different from what is claimed. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups I and IV as related as product and process of use. Citing MPEP §806.05(h), the Office suggests that the claimed product can be used in a materially different process “when an ionographic pen forms an electrostatic latent image on the surface of the photoreceptor, the image is developed with toner, and the toner is fixed on the surface of the photoreceptor.” However, there is no evidence of record to show that the claimed product is useful as the Office has alleged. In addition, the Office has failed to show that its alleged use of the claimed product is materially different from what is claimed. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups II and IV as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the coating solution is not disclosed for use in the method and there is no indication that the solution could be used in the method”. However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

In regard to Groups III and IV, the Office has characterized the relationship between these two groups as subcombinations disclosed as usable together in a single combination. Citing MPEP §806.05(d), the Office concludes that “invention III has separate utility such as form forming a photoreceptor useful in an ionographic imaging process.” However, the Office has not provided reasons and/or examples to support this conclusion. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

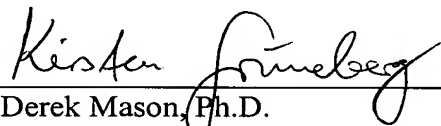
Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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